

Filed by:

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Administrative Patent Judge
Board of Patent Appeals and Interferences
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Paper 14

Filed:
23 December 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

HIROSHI HAMAMOTO, YOSHINORI SUGIYAMA,
NORIAKI NAKAGAWA, EIJI HASHIDA, SUGURU TSUCHIMOTO,
NORIYUKI NAKANISHI, YUJI MATSUNAGA,
and
YOSHIMI OKADA

Junior Party,
(Patent 5,618,699),

v.

THOMAS H. TURPEN,
STEPHEN J. REINL,
and
LAURENCE K. GRILL

Senior Party
(Application 09/057,016).

Patent Interference No. 105,149

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

MAILED

DEC 23 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Part A. Declaration of interference

An interference is declared (35 U.S.C. 135(a)) between the captioned parties. Details of the applications, patents, reissue applications, counts, and claims designated as corresponding to the counts appear under headings E and F of this NOTICE.

Part B. Judge designated to handle the interference

The interference has been assigned to Administrative Patent Judge James T. Moore. 37 CFR § 1.610.

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to set dates

A telephone conference call to set dates for action in this interference is scheduled for **2 p.m. (Eastern) on February 25, 2004.** (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See STANDING ORDER ¶10.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies the NOTICE DECLARING INTERFERENCE. Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a longer period.

E. The parties involved in this interference are:

Junior Party

Named Inventors: HIROSHI HAMAMOTO, Japan
YOSHINORI SUGIYAMA, Japan
NORIAKI NAKAGAWA, Japan
EIJI HASHIDA, Japan
SUGURU TSUCHIMOTO, Japan
NORIYUKI NAKANISHI, Japan
YUJI MATSUNAGA, Japan
YOSHIMI OKADA, Japan

Patent: 5,618,699, granted April 8, 1997 based on
Application 08/313,127, filed November 30, 1994

Title: Plant Virus Vector, Plasmid, Process for Expression of Foreign
Gene and Process for Obtaining Foreign Gene Product

Assignee: KANEBO, LTD (Japan)

Accorded Benefit: PCT Application PCT/JP93/00408,
filed March 31, 1993
Japanese Application 4-351970;
filed December 8, 1992
Japanese Application 4-188744,
filed June 22, 1992
Japanese Application 4-108628,
filed March 31, 1992;

Attorneys: See last page

Address: See last page

Senior Party:

Named Inventors: THOMAS H. TURPEN, Vacaville, CA
STEPHEN J. REINL, Sacramento, CA
LAURENCE K. GRILL, Vacaville, CA

Application: 09/057,016, filed April 7, 1998

Title: Production of Peptides in Plants as Viral Coat Protein Fusions

Assignee: BIOSOURCE TECHNOLOGIES, INC. (US)

Accorded benefit: United States Application 08/324,003, filed October 14, 1994, now
United States Patent 5,977,438 issued November 2, 1999

United States Application 08/184,237, filed January 19, 1994, now
United States Patent 5,589,367 issued December 31, 1996

United States Application 08/176,414, filed December 29, 1993,
now United States Patent 5,811,653 issued September 22, 1998

United States Application 07/997,733, filed December 30, 1992;
now abandoned

United States Application 07/923,692, filed July 31, 1992, now
United States Patent 5,316,931 issued May 31, 1994

United States Application 07/739,143, filed August 1, 1991, now
abandoned

United States Application 07/737,899, filed July 26, 1991, now
abandoned

United States Application 07/641,617, filed January 16, 1991, now
abandoned

United States Application 07/600,244, filed October 22, 1990, now
abandoned

United States Application 07/363,138, filed June 8, 1989, now
abandoned

United States Application 07/347,637, filed May 5, 1989, now
abandoned

Senior Party, Continued

United States Application 07/310,881, filed February 17, 1989,
now abandoned

Attorneys: See last page

Address: See last page

F. Counts and claims of the parties

Count 1

A process for systemically expressing a fusion protein of a coat protein of a Tobamovirus and a foreign protein in a plant comprising the steps of:

(a) inoculating a plant with a plant virus vector, such that upon expression of the vector in a plant, the coat protein of a Tobamovirus and the fusion protein of the coat protein and the foreign protein are systemically produced in the plant; and

(b) expressing the fusion protein systemically in the plant.

The claims of the parties are:

Hamamoto: Claims 1-25

Turpen: Claims 17 and 18

The claims corresponding to Count 1:

Hamamoto: Claims 16 and 17

Turpen: Claims 17 and 18

The claims not corresponding to Count 1:

Hamamoto: Claims 1-15 and 18-25

Turpen: None

G. Heading to be used on papers

Addendum 1 provides the heading that shall be used on all papers filed in the interference. See STANDING ORDER ¶3.5.

H. Summary of dates for taking action

Addendum 2 provides a summary of dates and times for taking action set in the STANDING ORDER.

I. Order form for requesting file copies


Addendum 3 provides an order form for requesting file copies. Use of the form will expedite the processing of your request.

J. Notice of intent to publish

In the event that this proceeding should result in a decision or order that the Board believes would be of interest to the public, the decision or order will be published without redaction unless, within sixty days of the entry date of this notice of declaration a party files as a separate paper a notice that specifically identifies information in its application that is not already publicly available that would warrant redaction.

If, after filing such notice, specifically identified information becomes publicly available (for example, through publication of a collateral application), the party shall promptly notify the Board of this change in the status of the information.

The parties are reminded that, in any case, at the end of the proceeding all of the information in the proceeding may be publicly available pursuant to 37 CFR § 1.11(e).


JAMES T. MOORE
Administrative Patent Judge

Enclosures:

- Copy of STANDING ORDER (Paper 002)
- Copy of sample order used for setting times for taking action in the preliminary motion phase of the interference
- Copy of sample order used for setting times for taking action in the priority phase of the interference
- Form PTO-850
- Copy of the Claims for 09/057,016
- Copy of US Patent 5,618,699

ADDENDUM 1

Paper _____¹

Filed on behalf of [name of party]

By: Name of lead counsel

Name of backup counsel

Street address

City, State, and ZIP Code

Tel:

Fax:

email@isp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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Patent Interference No. 105,149

TITLE OF PAPER

¹ Leave blank, the Board will administratively assign the paper number.

ADDENDUM 2

SUMMARY OF DATES FOR TAKING ACTION

Dates and times for taking action are set in the following paragraphs of the
STANDING ORDER:

| <u>Date</u> | <u>Paragraph</u> |
|---|------------------|
| Identifying lead and backup counsel | 4 |
| Identifying any and all real parties in interest | 5 |
| Requesting copies of involved and benefit applications and patents | 6 |
| Accomplishing certain discovery | 7 |
| Filing clean copy of claims | 8 |
| Filing clean copy of claims in cases with drawings or claims containing a means plus function limitation | 9 |
| Filing list of proposed preliminary motions | 10 |
| Filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions | 13.10.2 |
| Objecting to admissibility of evidence | 14.1.1 |
| Serving supplemental affidavits or evidence to respond to objection to admissibility of evidence | 14.2 |
| When cross-examination can take place | 14.3 |
| Taking action with respect to settlement discussions | 15.2 |

ADDENDUM 3

FILE COPY REQUEST
Patent Interference No. 105,149

Attach a copy of all pages of section E of this NOTICE to this REQUEST. On the copy, please circle each patent and application that you are requesting.

Include the following information to facilitate processing of this REQUEST:

1. Please copy and send one copy of the patent application files circled on attached section E to the address listed below.
2. Please charge fees and costs to USPTO Deposit Account No. _____.
3. Please send the copies to the street address listed below. (Note: please provide a complete physical address, including street, city, state, zip code and telephone number - do not list a Post Office box because file copies are sent by commercial overnight courier):

4. Any questions should be directed to the telephone number listed below (please include area code:

() - .

cc: (via Federal Express)

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